

Remarks

Claims 1-14 and 16-20 are presently pending in this application. Claims 1, 16, 19, and 20 are independent. In the Office Action of March 11, 2005, the Examiner rejected claims 1-19. Claim 10 is being amended herein for greater clarity and not for any reasons related to patentability. The amendments are submitted without prejudice to the Applicant's ability to pursue the originally claimed subject matter in a continuing application. No new matter has been added. The Applicant traverses the rejections of claims 1-19 and respectfully requests reconsideration.

Rejection under 35 U.S.C. § 112

The Examiner rejected claims 3, 10, and 13 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Applicant respectfully traverses each of these rejections and requests reconsideration.

Definiteness of claim language "must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." MPEP § 2173.02.

With respect to claim 3, one of ordinary skill in the art of trading would understand the phrase "attempts to achieve" a price, because achieving a particular price in trading is not always guaranteed. Claim 3 is not limited to achieving a particular price, but rather calls for an attempt to achieve the particular price. Additionally, claim 3 specifically recites how "attempts to achieve a price" occurs - "by automatically sending and managing an order in the first real market, in the second real market, or in both the

first and second real markets.” Applicant’s specification also provides discussion related to the “attempts to achieve a price” on page 12, line 22 – page 13, line 2, as well as page 15, lines 16-20. Therefore, the Applicant contends that Claim 3 meets the statutory requirements of 35 U.S.C. §112.

With respect to claim 10, one of ordinary skill in the art would have known what “an opportunity” means in the context of trading. However, Applicant amended claim 10 for greater clarity to now recite “a desired trading opportunity.” A few examples of “a desired trading opportunity” are provided in the Applicant’s specification on page 8, lines 17-20 - page 9, lines 1-2, and page 18, lines 19-22 – page 19, lines 1-6. One of ordinary skill in the art would also understand the amended phrase “a desired trading opportunity,” based, at least in part on the few examples provided in the Applicant’s specification. Therefore, the Applicant contends that the amended Claim 10 also meets the statutory requirement of 35 U.S.C. §112.

The Examiner referred to Claim 13 with respect to the rejection of the claim reciting the “computer readable medium.” Applicant notes that Claim 15, not claim 13, recites “computer readable medium.” In an effort to advance prosecution, Applicant cancelled Claim 15, and added a new independent Claim 20 reciting the computer readable medium, as suggested by the Examiner.

Thus, Applicant contends that each of the rejected claims meets the statutory requirement of 35 U.S.C. §112.

Rejection under 35 U.S.C. § 103

The Examiner rejected claims 1-19 under 35 U.S.C. § 103(a) as being unpatentable over Singer in view of Keith. Applicant traverses the rejections of the claims 1-19, and respectfully requests reconsideration.

According to M.P.E.P. § 2143, in order to establish the required prima facie case of obviousness of claimed invention, the reference (or references when combined) must teach all the claim limitations.

The patent application 10/727,466 and the Singer reference 10/705,037 were, at the time the invention of application 10/727,466 was made, jointly owned by Trading Technologies, the Applicant. According to M.P.E.P. § 706.02(l)(1), effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention “were at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” Therefore, the Applicant respectfully requests to disqualify Singer as a reference.

Keith does not disclose, show, or suggest the Applicant’s claimed invention. More specifically, Keith does not disclose or suggest: “initiating a first order associated with a spread at a desired spread price in a synthetic spread market, wherein the synthetic spread market is associated with a first real market and a second real market, and wherein the first real markets are offered by at least one electronic exchange,” as claimed, for example, in Applicant’s Claim 1. Keith also does not disclose or suggest: “in response to initiating the first order, automatically sending a second order to an exchange-provided spread market, wherein the synthetic spread market and the exchange-provided spread

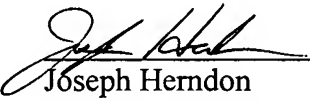
market offer interchangeable tradeable objects,” as also claimed, for example, in Applicant’s Claim 1. The other independent claims include similar limitations, and thus are patentable over Keith for similar reasons.

Conclusion

In view of the reasons provided above, the Applicant submits that the invention as claimed in claims 1-14 and 16-20 patentably distinguish over the Keith reference. Therefore, the Applicant submits that each of these claims is in condition for allowance, and the Applicant respectfully requests favorable reconsideration. If the Examiner believes that further dialog would expedite consideration of the application, the Examiner is invited to contact Monika Dudek at (312) 476-1118 or the undersigned attorney/agent.

Respectfully submitted

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